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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,273	11/21/2000	Hubert Helaine	Q61623	8432
23373	7590	11/28/2007		
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER IQBAL, KHAWAR	
			ART UNIT 2617	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/716,273	<b>Applicant(s)</b> HELAINÉ ET AL.	
	<b>Examiner</b> Khawar Iqbal	<b>Art Unit</b> 2617	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Reopening of Prosecution-New ground of Rejection After Appeal***

In view of the appeal Brief filed on 9/10/2007, PROSECUTION IS HEREBY REOPENED. The rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 22 rejected under 35 U.S.C. 102(e) as being anticipated by Shah (6029065).

Regarding claim 22 Cassidy et al teaches a method of updating provisioning data in a telecommunications terminal for accessing a network via an access network and an access provider, the method comprising (figs. 1-3):

backing up provisioning data for an access network, an access provider or a user (when the user accesses a feature using the familiar method, e.g. menu or code sequence, the mobile converts the codes to the equivalents supplied. The converted codes are sent to the network. Each time the mobile connects with the network it checks the feature codes available and updates its list with any new codes for the features) (col. 4, lines 1-26 and 45-55, col. 8, lines 5-48); and

protecting the backed up provisioning data to prevent it being updated without the intervention of the user, an access network operator or the access provider (col. 8, lines 35-45).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2,4-9, 11-16, 18-21, 23-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cassidy et al (6480725) in view of Shah (6029065).

5. Regarding claim 1 Cassidy et al teaches a telecommunication terminal (fig. 1) for accessing a data network via an access data network using a set of provisioning data, the terminal comprising (figs. 1,5-7):

means for storing a current set of provisioning data (Figs. 1,2a, Subscriber data store on the SIM card 10,col. 4, lines 37-57, col. 5, lines 15-28);

means for storing at least one set of protected provisioning data (Figs. 1,3a, ID data store on the EEPROM 6, col. 5, lines 39-54); and

means for selecting a set of provisioning data from a group of the current set of primary provisioning data and the set of protected primary provisioning data (col. 6, lines 13-26,col. 7, lines 29-43);

wherein a connection to the data network is set up using the selected set of provisioning data (Note: Cassidy et al teach data store in SIM card, used to enable communication on an appropriate network) (col. 4 , lines 52-55). Cassidy et al does not teach one set of provisioning data cannot be updated without the intervention of the terminal user.

In a similar field of endeavor, Shah discloses one set of provisioning data that cannot be updated without the intervention of the terminal user (col. 8, lines 32-47). At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Cassidy et al to make user friendly by enabling mobile users to readily access network features across multiple networks without requiring the user to learn additional feature codes.

Regarding claim 8 Cassidy et al teaches a telecommunication terminal for accessing a network via an access data network using a set of provisioning data, the terminal comprising (figs. 1-7):

means for storing a current set of provisioning data (Figs. 1,2a, Subscriber data store on the SIM card 10, col. 4, lines 37-57, col. 5, lines 15-28), means for storing at least one set of protected provisioning data (Figs. 1,3a, ID data store on the EEPROM 6, col. 5, lines 39-54), and

means for selecting a set of provisioning data from a group of the current set of primary provisioning data and the set of protected primary provisioning data (col. 6, lines 13-26,col. 7, lines 29-43);

wherein a connection to the data network is set up using the selected set of provisioning data (Note: Cassidy et al teach data store in SIM card, used to enable communication on an appropriate network) (col. 4, lines 52-55). Cassidy et al does not teach one set of provisioning data cannot be updated without the intervention of the terminal user.

In a similar field of endeavor, Shah discloses one set of provisioning data that cannot be updated without the intervention of the terminal user (col. 8, lines 32-47). At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Cassidy et al to make user friendly by enabling mobile users to readily access network features across multiple networks without requiring the user to learn additional feature codes.

Regarding claim 15 Cassidy et al teaches a telecommunication terminal for accessing a network via an access data network using a set of provisioning data, the terminal comprising (figs. 1-7):

means for storing a current set of provisioning data (col. 6, lines 13-26,col. 7, lines 29-43);

means for storing at least one set of protected provisioning (Figs. 1,3a, element 6, col. 5, lines 39-54);

means for selecting a set of provisioning data from a group of the current set of primary provisioning data and the set of protected primary provisioning data (col. 6, lines 13-26, col. 7, lines 29-43); wherein a connection to the data network is set up using the selected set of provisioning data (Note: Cassidy et al teach data store in SIM card, used to enable communication on an appropriate network)(col. 4, lines 52-55). Cassidy et al does not teach one set of provisioning data cannot be updated without the intervention of the terminal user.

In a similar field of endeavor, Shah discloses one set of provisioning data that cannot be updated without the intervention of the terminal user (col. 8, lines 32-47). At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Cassidy et al to make user friendly by enabling mobile users to readily access network features across multiple networks without requiring the user to learn additional feature codes.

Regarding claims 2,9,16 Cassidy et al teaches wherein the terminal is a mobile terminal (Fig. 1).

Regarding claims 4, 11, 18 Cassidy et al teaches wherein the protected provisioning data storage means are adapted to store a plurality of sets of provisioning data for a plurality of accesses to the data network (col. 5, line 15-col. 6, line 35, col. 7, lines 1-50).

Regarding claims 5, 12 and 19 Cassidy et al teaches wherein it includes identification data storage means for each provisioning set stored in the protected provisioning data storage means (col. 5, line 15-54).

Regarding claims 6, 13, 20 Cassidy et al teaches wherein the protected provisioning data storage means are in a medium dedicated to an access network or to an operator (col. 5, line 15-54).

Regarding claims 7 and 21 Cassidy et al teaches wherein the protected provisioning data storage means are in a medium dedicated to an access or content provider (col. 5, line 15-54).

Regarding claims 23, 27 Cassidy et al teaches a method of accessing a network by a telecommunication terminal, the method comprising (figs. 1-7):

identifying a user and a network using the terminal (Figs. 1,3a, col. 5, lines 39-54, col. 1, line 63-col. 2, line 65);

when the user and the network are identified, checking storage for a protected provisioning data (col. 6, lines 13-26,col. 7, lines 29-43);

when said provisioning data is detected, using said provisioning data; and  
when said provisioning data is not detected, requesting current provisioning data (col. 6, lines 13-26);



wherein said storage is in one of: the terminal; a medium dedicated to an access provider; a medium dedicated to an access network (col. 6, lines 13-26, col. 7, lines 29-43), wherein before storing in said storage said protected provisioning data, the user is queried whether said protected provisioning data is to be stored (col. 6, lines 13-26, col. 7, lines 29-43). Cassidy et al does not teach data cannot be updated without the intervention of the terminal user.

In a similar field of endeavor, Shah discloses data that cannot be updated without the intervention of the terminal user (col. 8, lines 32-47). At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Cassidy et al to enable mobile users to readily access network features across multiple networks without requiring the user to learn additional feature codes.

Regarding claim 24 Cassidy et al teaches wherein the provisioning data is primary provisioning data to access the data network (col. 6, lines 13-26).

Regarding claim 25 Cassidy et al teaches wherein both the means for storing a current set of provisioning data and the means for storing at least one set of protected provisioning data are located in at least one of storage of the terminal and on a card insertable into the terminal (col. 6, lines 13-26, col. 7, lines 29-43).

Regarding claim 26 Cassidy et al teaches wherein the means for storing a current set of provisioning data and the means for storing at least one set of protected provisioning data, each store data for setting up a connection to the data network via a respective access networks for the same terminal and wherein connections to different

access networks are established with different stored sets of provisioning data (col. 6, lines 13-26, col. 7, lines 29-43).

Regarding claim 28 Cassidy et al teaches wherein, when the terminal returns to a home access network, said one of said at least one set of protected primary provisioning data is copied from the protected storing means into the current storing means (col. 6, lines 13-26,col. 7, lines 29-43).

Regarding claims 29-31 Cassidy et al wherein the current set of primary provisioning data is updated automatically without intervention of the terminal user (col. 6, lines 13-26,col. 7, lines 29-43).

6. Claims 3, 10, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cassidy et al (6480725) in view of Shah (6029065).

7. Regarding claims 3, 10, 17 Cassidy et al and Shah does not specifically teach packet switched data network. In a similar field of endeavor, Beaudou discloses packet switched data network (col. 9, line 35-col. 10, line 35, col. 8, lines 13-50). At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Cassidy et al and Shah to include connection to the data network for using information for the purpose of allowing connection in a packet switched data using Internet protocol or wireless application protocol.

#### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-31 have been considered but are moot in view of the new ground(s) of rejection.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khawar Iqbal whose telephone number is 571-272-7909.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, GEORGE ENG can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

*Khawar Iqbal*

  
GEORGE ENG  
SUPERVISORY PATENT EXAMINER